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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,704	06/07/2001	James S. Mrozinski	55870US002	9401

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EXAMINER

TRAN, SUSAN T

ART UNIT PAPER NUMBER

1615

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/876,704

Applicant(s)

MROZINSKI ET AL.

Examiner

Susan T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-10,12-15,18-33 and 35-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-10,12-15,18-33 and 35-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of applicant's Amendment and Terminal Disclaimer filed 05/13/05.

Terminal Disclaimer

The terminal disclaimer filed on 05/13/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of USPN 6,638,611 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Double Patenting

The obviousness double patenting rejection over US 6,645,611, and the provisional obviousness double patenting rejection over copending application 10/001,094 have been withdrawn in view of applicant's amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4-10, 12-15, 18-33 and 35-72 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. It appears that applicant's specification does not provide support for the limitations "absorption of oil on the first face", and "said coating covering the porous substrate second face". It appears from applicant's specification that the coating is on at least a portion of at least one face of the porous substrate. Applicant's specification does not provide support for the limitation that the absorption is necessary to be on the opposition face (first face) of the coating since the coating is on at least a portion of at least one face. In accordance with MPEP § 714.02, applicant should specifically point out support for any amendment made to the disclosure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-10, 13-15, 18-25, 28-33, 37, 38, 41-55, 57-66, and 69-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. WO 99/29220.

Kondo teaches oil absorbing sheet comprising porous plastic film sheet, e.g., polypropylene, polyethylene, polybutylene, ethylene-propylene block copolymer, or poly-4-methylpentene; and coating, including about 20-60% fillers, e.g., mineral oils, and other additives (pages 4, and 6-7). The porous film sheet has interstitial volume in

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the range of 0.0001-0.005 cm³, void content in the range of 5-50%, the thickness in the range of 5-200µm, and oil absorption per unit of up to 3.78 mg/cm² (pages 5, 8, and 14-22). Other additives in the coating include surface- active agent and hydrophilic polymer, e.g., polyvinyl alcohol, and polyethylene glycol; and wherein the coating can be on a single or both surfaces of the film (pages 9-11). Kondo does not specifically teach the transparency of less than 65 percent. However, Kondo teaches excellent transparency, notable transparency enabling easy confirmation of oil absorption (page 8 and examples). Accordingly, absent showing evidence on the contrary, the transparency taught by Kondo is at least the same as the claimed transparency. Therefore, it would have been *prima facie* obvious for one of ordinary skill in the art to, by routine experimentation obtain the claimed invention because Kondo recognizes the same results desired by the applicant, e.g., excellent absorption of the skin oil, notable transparency, suitable to absorb large amount of sweat and skin oil on the face (page 1).

Claims 12, 26, 27, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al., and Sugiyama et al. US 4,643,939.

Kondo is silent as to the teaching of polyolefin microfiber and salicylic acid. However, it is the position of the examiner that polyolefin is of the same polymer group as polypropylene, and therefore, it would have been obvious for one of ordinary skill in the art to, by routine experimentation select a suitable thermoplastic film and a suitable organic acid with the expectation of at least similar result, because Kondo teaches

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thermoplastic film material including polypropylene microfiber; filler, such as organic and inorganic acid.

Sugiyama teaches oil-absorbing tissue made of plant fiber, or mixture of plant fiber and synthetic resin fiber (column 2, lines 30-38). The sheet is coated with additives, such as salicylic acid (column 2, lines 39-68). Thus, it would have been obvious for one of ordinary skill in the art to modify Kondo's oil-absorbing sheet with the plant fiber in view of Sugiyama with the expectation of at least similar result, because the references teach the advantageous results in the use of oil-absorbing sheet. The expected result would be oil-absorbing sheet having excellent absorption of the skin oil, and notable transparency to enable easy confirmation of oil absorption and toughness.

Claims 35, 36, 39, 40, 67, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al.

Kondo is silent as to the teaching of the average pore size and the "Hand" of the sheet. However, absent showing evidence on the contrary, it is the position of the examiner that the oil absorbing sheet taught by Kondo would have at least similar pore size and "Hand" weight as the claimed pore size, because, Kondo uses the same thermoplastic film having the same physical properties, e.g., void volume, interstitial volume, and thickness.

Response to Arguments

Applicant's arguments filed 05/13/05 have been fully considered but they are not persuasive.

Applicant argues that the rejection over Kondo is inappropriate for the following reasons:

1) The additives mentioned on pages 6-7 are used to form the porous film. In response to applicant's argument, it is noted that the features upon which applicant relies (i.e., additives on pages 6-7, and additives used to form the porous film) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Nothing recited in the claims to restrict the claims to the limitation that the additives are the main ingredients in the porous film.

2) The claims are now clearly define two faces for the porous substrate. One face of the wipe is formed by the porous substrate. This is the porous substrate that would have the additives listed on pages 6-7, which mainly are fillers to form the pores and acids which act as nucleating agents for initiation of the pore formation. However, nowhere in the claims require one face of the wipe is formed by the porous substrate. This is the porous substrate that would have the additives listed on pages 6-7, which mainly are fillers to form the pores and acids that act as nucleating agents for initiation of the pore formation.

3) The claims require the film forming polymer form a coating is on a give face of the porous substrate where the coating does not penetrate through the porous substrate to the opposite face of the porous substrate. However, the limitation "coating on at least a portion of the second face" would permit the coating to be on *any* given face, because application specification does not provide adequate support for the clear distinction of the first face and second face. Applicant's specification does not disclose/define the term "fist face" or "second face", and therefore, it can be interpreted as any give face. Accordingly, no criticality is seen in the future intended use of the limitation "coating does not penetrate through the porous substrate to the apposite face of the porous substrate" when the same result is obtained by Kondo, namely, an oil absorbent sheet that has excellent oil absorbance, notable transparency, and can absorb a large amount of sweat and skin oil dissolved therein on the face (page 1, lines 10-14).

4) The additives to the film forming polymer of the claimed invention are additives that deliver a benefit to the skin or hair upon wiping. The additives taught by Kondo are used to modify the characteristics of the porous film which is a polymeric material and these additives would provide no benefit to the skin or hair. None of these additives are additives which are even capable of providing benefit to skin or hair. However, *mineral oil*, filler, and *organic acid* disclosed at pages 6-7 are well-known skin benefiting component. See for example Wu et al. using organic acid, such as salicylic acid in a formula useful for skin. Accordingly, it is the position of the examiner that the oil absorbing sheet of Kondo would be capable of providing benefit to the skin or hair upon wiping. The burden of proof is shifted to applicant to provide data showing that the oil

absorbing sheet of Kondo does not provide any benefit to the skin or hair when wipe. Furthermore, it would have been obvious to one ordinary skill in the art to optimize the oil absorbing sheet of Kondo to include additives that can provide benefit to the skin.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Correspondence


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan T. Tran whose telephone number is (571) 272-0606. The examiner can normally be reached on M-R from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached at (571) 272-0602. The fax phone

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number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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